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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,983	03/14/2002	Florence L'Alloret	220759USOPCT	4740

22850 7590 08/25/2004

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

EGWIM, KELECHI CHIDI

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/069,983	L'ALLORET, FLORENCE	
	<b>Examiner</b>	<b>Art Unit</b>	
	Dr. Kelechi C. Egwim	1713	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 June 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 44-49 and 104-148 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 44-46, 104, 110, 116, 119, 125, 126, 131, 134-136, 143 and 144 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 47-49,105-109,111-115,117,118,120-124,127-130,132,133,137-142 and 145-148.

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election with traverse of species a), c) and f) in the reply filed on 06/10/2004 is acknowledged. The traversal is on the ground(s) that the Office provides no support for its conclusion that the alternative chemical compounds in the claims are so dissimilar that they fail to meet the requirements of PCT Rule 13.2. This is not found persuasive since the distinctions and dissimilarities between of the compounds would be clear to one ordinary skill in the art.

Applicant also argues that the Office has not applied the same standard of unity of invention as the International Preliminary Examination Authority since the Authority did not take the position that unity of invention was lacking in the International application and examined all claims together. However, since the restricted claims are new and were not present in the PCT application, applicant's arguments have no basis.

Finally applicant states that a search of all the claims would not impose a serious burden on the Office. This argument is not found persuasive since the search for one species would not necessarily uncover the others and the others would require a separate and/or additional search.

Moreover, the response states that "[a]pplicants make no statement regarding the patentable distinctness of the species". If applicant makes no statement with regard to the patentable distinction of the species, then the statement by the examiner that the species **are** patentably distinct is ultimately unrefuted.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 105, 113, 122 and 124 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected species, there being no allowable generic or linking claim. Currently, claims 47-49, 105-109, 111-115, 117, 118, 120-124, 127-130, 132, 133, 137-142 and 145-148 are still present in the application, but are finally withdrawn from consideration.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 119 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 119 recites the limitation "wherein the units with an LCST comprises one or more of the following polymers", wherein the "polymers" include several vinyl and ethylenically unsaturated monomers. There is insufficient antecedent basis for polymers that are simple vinyl monomers in the claim.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 44-46, 104, 110, 116, 119, 125, 126, 131, 134-136 and 143-144 are rejected under 35 U.S.C. 102(b) as being anticipated by Merchant Jr. et al. (USPN 4,737,265), Yamamoto et al. (USPN 4,839,167) or Breneman et al. (USPN 5,338,352), Ezaki et al. (JP 61245835), Koerner et al. (USPN 4,274,977), Fogel et al. (USPN 4,559,226), Yabuta et al. (EP 1055694) or Maroy et al. (EP 583814 or EP 629649)

Each of Merchant Jr. et al. (col. 3, lines 39-50, col. 5, lines 33-66 and col. 6, lines 33-49), Yamamoto et al. (col. 2, lines 10-46 and col. 4, line 45-47), Breneman et al. (col. 2, lines 10-16, col. 6, lines 34-67 and col. 7, lines 25-33), Ezaki et al. (See abstract), Koerner et al. (col. 2, lines 13-18, col. 6, lines 24-28 and the examples), Fogel et al. (col. 1, lines 10-13, col. 4, lines 46-48, col. 5, lines 63-66 and col. 7, lines 45-48), Yabuta et al. (page ¶ 14 and page 11, ¶ 97 and 100) and Maroy et al. (whole documents) teach adding to water, for the purpose of lower its surface tensions, a water-soluble polymer having units resulting in an LCST (lower critical solution temperature or cloud point) within the range recited in the present claims, wherein the water-soluble/LCST units are among the units recited in the present claims.

Thus, the requirements for rejection 35 U.S.C. 102(b) have been met.

### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 44-46, 104, 110, 116, 119, 125, 126, 131, 134-136 and 143-144 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 25-67 of copending Application No. 10/069,981. Although the conflicting claims are not identical, they are not patentably distinct from each other because you cannot have the product of 10/069,981 without caring out the method of the present claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (571) 272-1099. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should



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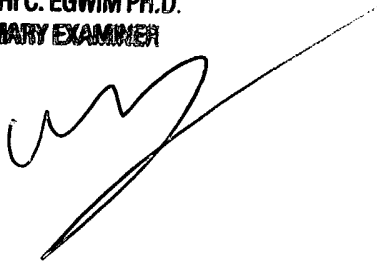
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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KCE

**KELECHI C. EGWIM PH.D.**  
**PRIMARY EXAMINER**

A handwritten signature in black ink, appearing to be 'KE', with a long, sweeping diagonal line extending from the bottom left towards the upper right.